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09/780,636	02/10/2001	Marc Alan Ehrlich	ARC920000113US1	9342

7590

10/29/2003

Samuel A. Kassatly  
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EXAMINER
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MATZ, DANIEL R

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/780,636

Applicant(s)

EHRlich ET AL.

Examiner

Daniel Matz

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 27-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 27-46 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 27-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention as originally claimed comprises (1) a system for automating an electronic-commerce transaction (claims 1-8), (2) a shopping agent site for automating an electronic-commerce transaction (claims 9-10), (3) a method for automating an electronic-commerce transaction (claims 11-17), and (4) a computer program product for automating an electronic-commerce transaction (claims 19-20). Newly added claims 21-26 depend from these originally presented claims.

Applicant has further added claims drawn to (1) an electronic-commerce service (claims 27-33), (2) an electronic-commerce service model (claims 34-40), and (3) a second computer program product (claims 41-46).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3641

3. Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-26 recite the limitation "the user profile database." Because the base claims have been amended to remove discussion of the user profile database, there is now insufficient antecedent basis for this limitation in these claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Published International Patent Application WO 00/31657 by Van Den Berghe et al., in view of USPN 6,125,352 granted to Franklin et al.

Regarding claim 1, Van Den Berghe et al. disclose (fig. 4; page 11, line 36 – page 13, line 25) a system for automating an electronic-commerce transaction using a virtual shopping cart initiated at a host site (403), comprising:

a merchant schema database (402) that contains information about schemas used by a plurality of heterogeneous merchants' sites;

a shopping cart manager (405) that creates the virtual shopping cart based on a user's search query, and that monitors the content of the virtual shopping cart;

and a shopping engine (401) that automatically collects and manages information from the plurality of heterogeneous merchants' sites, across multiple independent transaction sessions initiated by the host site (403), based on the user's search query, and that returns a corresponding comparative search result, without requiring the user to leave the host site to visit the plurality of heterogeneous merchants' sites. Van Den Berghe et al. do not specifically disclose a comparison shopping engine, (although comparison shopping would be enabled by the system of Van Den Berghe et al., since a user would be enabled to shop for the same item at a number of different sites). Franklin et al. teach (see abstract) an e-commerce shopping cart system allowing comparison shopping (see abstract), which is clearly desirable in order to ensure a user is paying the lowest price for a product. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a comparison shopping engine into the electronic commerce system of Van Den Berghe et al. in order to ensure a user is paying the lowest price for a product.

Regarding claim 2, Van Den Berghe et al. disclose a system further comprising a shopping coordinator (405; page 12, lines 9-15) that executes a desired shopping request for at least one item in the virtual shopping cart.

Regarding claim 3, Van Den Berghe et al. disclose a system further comprising a protocol broker module (401) that communicates with at least one of the plurality of heterogeneous merchants' sites using at least one of the schemas in the merchant schema database.

Regarding claim 4, Van Den Berghe et al. disclose a system further comprising a user profile manager (401) that maintains the user profile database and the merchant schema database.

Regarding claim 5, Van Den Berghe et al. disclose a system further comprising a shopping cart database (405) that stores a plurality of data structures necessary to manage a plurality of shopping carts and items contained in the plurality of shopping carts.

Regarding claim 6, Van Den Berghe et al. disclose a system (fig 4 and fig. 5; page 13, line 27 – page 14, line 36) wherein the merchant schema database (402) contains information about the plurality of merchants, their communication protocols, and how any one or more of the following functions are implemented for each merchant:

add function, that adds an item to the virtual shopping cart (page 14, step 3);

checkout function, that guides the shopper through a check out process (page 14, step 4.3);

account retrieval feature, that provides account information (page 14, step 4).

Van Den Berghe et al. do not specifically disclose a confirm order feature.

Franklin et al. teach (col. 27, lines 35-39) and confirm order feature to prevent unintended orders from being processed. Thus, it would have been obvious to one of ordinary skill to add a confirm order feature.

Regarding claim 7, Van Den Berghe et al. disclose a system wherein the protocol broker (Parsing Proxy Server, or PPS; see abstract) parses and analyzes the shopping

Art Unit: 3641

request related to an item in the virtual shopping cart, to retrieve a corresponding merchant protocol from the merchant schema database.

Regarding claim 8, Van Den Berghe et al. disclose a system wherein the corresponding merchant protocol is HTTP (page 3, line 25), and information related to the item in the virtual shopping cart is encoded, at least in part, in HTML (page 3, line 20).

Regarding claim 9, Van Den Berghe et al. disclose a shopping agent site for automating an electronic-commerce transaction using a virtual shopping cart initiated at a host site, having the claimed features as discussed above regarding claim 1.

Regarding claim 10, Van Den Berghe et al. disclose a shopping agent site, further comprising:

a shopping coordinator (405; page 12, lines 9-15) that executes a desired shopping request for at least one item in the virtual shopping cart;

and a protocol broker module (401) that communicates with at least one of the plurality of heterogeneous merchants' sites using at least one of the schemas in the merchant schema database.

Regarding claim 11, Van Den Berghe et al. disclose a method (fig. 4; page 11, line 36 – page 13, line 25) of automating an electronic-commerce transaction using a virtual shopping cart initiated at a host site, comprising:

storing information about a plurality of schemas used by a plurality of heterogeneous merchants' sites (the DPS, 402, is a database used to store merchant-specific data; page 13, lines 16-18);

Art Unit: 3641

creating the virtual shopping cart based on a user's search query (405);  
monitoring the content of the virtual shopping cart (done by PPS, 401; page 12, line 17 – page 13, line 25);  
and collecting and managing information across multiple independent transaction sessions from the plurality of heterogeneous merchants' sites, based on the user's search query (done by PPS, 401; page 12, line 17 – page 13, line 25);  
without requiring the user to leave the host site to visit the plurality of heterogeneous merchants' sites. Van Den Berghe et al. do not specifically disclose a method including a comparison shopping engine, (although comparison shopping would be enabled by the system of Van Den Berghe et al., since a user would be enabled to shop for the same item at a number of different merchant sites). Franklin et al. teach (see abstract) an e-commerce shopping cart system and method allowing comparison shopping (see abstract), which is clearly desirable in order to ensure a user is paying the lowest price for a product. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a comparison shopping engine into the electronic commerce method of Van Den Berghe et al. in order to ensure a user is paying the lowest price for a product.

Regarding claim 12, Van Den Berghe et al. disclose a method, further comprising executing a desired shopping request for at least one item in the virtual shopping cart (page 12, lines 9-15).



Art Unit: 3641

Regarding claim 13, Van Den Berghe et al. disclose a method further comprising communicating with at least one of the plurality of heterogeneous merchants' sites using at least one of the schemas in the merchant schema database (page 12, lines 31-34).

Regarding claim 14, Van Den Berghe et al. disclose a method further comprising maintaining the plurality of data structures necessary and the plurality of schemas (page 13, lines 16-18).

Regarding claim 15, Van Den Berghe et al. disclose a method further comprising storing a plurality of data structures necessary to manage a plurality of shopping carts and items contained in the plurality of shopping carts (page 13, lines 20-25).

Regarding claim 16, Van Den Berghe et al. disclose a method wherein storing information about the plurality of schemas includes storing information about the plurality of merchants, their communication protocols, and how any one or more of the following functions are implemented for each merchant:

- add function, that adds an item to the virtual shopping cart (page 14, step 3);

- checkout function, that guides the shopper through a check out process (page 14, step 4.3);

- account retrieval feature, that provides account information (page 14, step 4).

Van Den Berghe et al. do not specifically disclose a confirm order feature.

Franklin et al. teach (col. 27, lines 35-39) and confirm order feature to prevent unintended orders from being processed. Thus, it would have been obvious to one of ordinary skill to add a confirm order feature.

Regarding claim 17, Van Den Berghe et al. disclose a method wherein collecting and managing information includes parsing and analyzing the shopping request related to an item in the virtual shopping cart, to retrieve a corresponding merchant protocol (Parsing Proxy Server, or PPS; see abstract).

Regarding claim 18, Van Den Berghe et al. inherently disclose (fig. 4) a computer program product for automating an electronic-commerce transaction using a virtual shopping cart initiated at a host site (403), comprising:

- a merchant schema database (402) that contains information about schemas used by a plurality of heterogeneous merchants' sites;

- a shopping cart manager (405) that creates the virtual shopping cart based on a user's search query, and that monitors the content of the virtual shopping cart;

- and a shopping engine (401) that automatically collects and manages information from the plurality of heterogeneous merchants' sites, across multiple independent transaction sessions initiated by the host site (403), based on the user's search query, and that returns a corresponding comparative search result, without requiring the user to leave the host site to visit the plurality of heterogeneous merchants' sites. Van Den Berghe et al. do not specifically disclose a comparison shopping engine, (although comparison shopping would be enabled by the computer program of Van Den Berghe et al., since a user would be enabled to shop for the same item at a number of different sites). Franklin et al. teach (see abstract) an e-commerce shopping cart system allowing comparison shopping (see abstract), which is clearly desirable in order to ensure a user is paying the lowest price for a product. Therefore, it would have been

Art Unit: 3641

obvious to one having ordinary skill in the art at the time the invention was made to incorporate a comparison shopping engine into the computer program product of Van Den Berghe et al. in order to ensure a user is paying the lowest price for a product. Note also that the system of Van Den Berghe et al. would necessarily need to be embodied as a computer program product in order to be carried out on the servers and web sites as shown.

As to limitations that are considered to be inherent in a reference, note the case law of In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al., 195 USPQ 430, and In re Brown, 173 USPQ 685, 688.

Regarding claim 19, Van Den Berghe et al. disclose a computer product further comprising a shopping coordinator (405; page 12, lines 9-15) that executes a desired shopping request for at least one item in the virtual shopping cart.

Regarding claim 20, Van Den Berghe et al. disclose a computer program product further comprising a protocol broker module (401) that communicates with at least one of the plurality of heterogeneous merchants' sites using at least one of the schemas in the merchant schema database.

Regarding claims 21-26, Franklin et al. teach a user profile database (510, 512, 514, 516) including the claimed features, and thus incorporation of such into the system, site, method, and computer program of Van Den Berghe et al. would have been obvious to one of ordinary skill.

Art Unit: 3641

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Matz whose telephone number is (703) 306-4164. The examiner can normally be reached on Mon-Thurs, alt Fri 7:30am to 4:30pm.

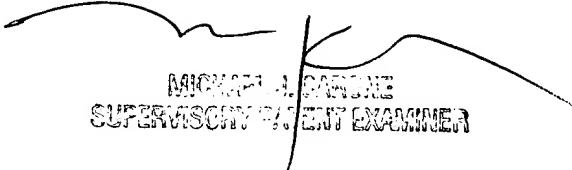
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4180.

DM

October 14, 2003



MICHAEL J. CARLINE  
SUPERVISORY/LEAD EXAMINER